

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

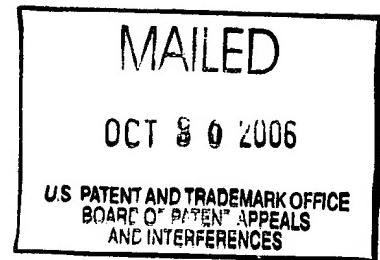
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte BRYAN C. GEBHARDT, HOUMAN AZARM, CHARLES N.
MCCULLOUGH and EDGARD S. VALDIVIA

Appeal No. 2006-2399
Application No. 09/843,614

ON BRIEF



Before HAIRSTON, JERRY SMITH and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-41, which constitute all the claims pending in this application.

The disclosed invention pertains to a computer implemented method and system for updating an interactive application broadcast from a broadcast system to a reception device over a broadcast medium.

Representative claim 1 is reproduced as follows:

1. A computer implemented method of updating an interactive application broadcast from a broadcast system to a reception device over a transmission medium, the method comprising:

receiving at the broadcast system a broadcast signal including at least one record of a first interactive application;

selecting a second interactive application, and broadcasting records of the second interactive application to the reception device in place of at least some of the records of the first interactive application, for execution of the second interactive application by the reception device;

receiving at the broadcast system in the broadcast signal one or more additional records of the first interactive application; and

broadcasting from the broadcast system selected ones of the additional records to the reception device, for execution of the second interactive application in conjunction with the additional records.

The examiner relies on the following references:

Filepp et al. (Filepp)	6,195,661	Feb. 27, 2001
Chen et al. (Chen)	6,269,374	July 31, 2001 (filed May 26, 1998)
Wistendahl et al. (Wistendahl)	6,496,981	Dec. 17, 2002 (filed Sep. 19, 1997)
Howe et al. (Howe)	6,502,242	Dec. 31, 2002 (filed Feb. 05, 1998)

Claims 1-41 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner offers Howe in view of Filepp with respect to claims 1-6, 9-13, 17-30, 33-36, 40 and 41; Chen is added to this combination with respect to claims 14-16 and 37-39; and Wistendahl is added to the main combination with respect to claims 7, 8, 31 and 32.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or

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her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189

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USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 1-6, 9-13, 17-30, 33-36, 40 and 41 based on Howe and Filepp. Since appellants essentially rely on their arguments with respect to independent claim 1 in support of all the claims subject to this rejection, we will consider claim 1 as the representative claim for this rejection. With respect to claim 1, the examiner finds that while Howe discloses providing update information to the second interactive application, Howe does not disclose the method of storing and updating records for the interactive applications.¹ The examiner finds that it would have been obvious to the artisan to combine the teachings of Filepp with regards to locating, object type matching, version checking, currency checking, caching and updating interactive application records into the methods of Howe [answer, pages 5 and 11-12].

Appellants argue that the selecting step of claim 1 is not taught or suggested by Howe. Specifically, appellants argue that there is no indication that the icon or ICA of Howe (the alleged first interactive application) has some records that may be replaced by records of the interactive program of Howe. Appellants argue that neither the callback address nor the icon of Howe is an “interactive application” as recited in claim 1, but that they are simply a means to access an interactive program in Howe. Appellants also assert that the ICA and the screen image are one-

¹ It is not clear exactly how this finding relates to representative claim 1.

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way mediums, and consequently, not interactive as claimed. Appellants also argue that there is a lack of motivation to combine the teachings of Howe and Filepp to arrive at the claimed invention [brief, pages 14-22].

The examiner responds that Howe presents an interactive button in order to allow the subscriber to input a selection of an interactive application, and that this button is used to indicate additional content. The examiner asserts that the screen image icon or button should be considered as an interactive application. The examiner essentially finds that since 1) the interactive button presents textual information to the subscriber, and 2) the interactive button is able to accept input from and respond to the user, the requirement for two-way communication is fulfilled by the screen image icon or button and there exists an interactive session between the interactive button and the subscriber. The examiner responds that the interactive button is an interactive application because Howe teaches that there could be multiple interactive buttons and that there is the possibility of dynamically updating the text information on the interactive button. The examiner also asserts that the invention of claim 1 should be interpreted to indicate replacement of a first broadcast signal containing information about a first interactive application with a second broadcast signal with information regarding a second interactive application [answer, pages 17-22].

Appellants respond that it is clear in Howe that the ICA itself is not an interactive application but a trigger sensed by the set top box to signal it to generate the interactive button. Appellants reiterate that Howe only teaches transitioning between an analog based television

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program to a second program, particularly an interactive program, and only in response to a set top box user's action [reply brief].

We will not sustain the examiner's rejection of representative claim 1 or of any of the other claims rejected on Howe and Filepp for essentially the reasons argued by appellants in the briefs. First, we agree with appellants that the ICA or icon of Howe is not an interactive application. Second, even if the ICA or icon of Howe could be considered to be an interactive application, the examiner has still failed to explain how the claimed first and second records are broadcast in the manner claimed. The portions of Howe cited by the examiner fail to support the examiner's generic findings that Howe teaches the claimed invention. Since the examiner's findings with respect to Howe are erroneous, and since Howe is necessary to support each of the examiner's rejections, we do not sustain any of the examiner's rejections of the claims on appeal.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-41 is reversed.

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REVERSED

Kenneth W. Hairston
KENNETH W. HAIRSTON
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

Allen Macdonald
ALLEN R. MACDONALD
Administrative Patent Judge

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